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EXAMINER

PACHOL, NICHOLAS C

ART UNIT	PAPER NUMBER
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2625

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/820,630	Applicant(s) GOLDSTEIN ET AL.	
	Examiner Nicholas C. Pachol	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-16, 18, 19, 21, 24, 52 and 72-76 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5, 7-9, 18, 19, 21, 24, 52 and 72-76 is/are rejected.
- 7) ☒ Claim(s) 2 and 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 07/19/10 have been fully considered but they are not persuasive.
2. In regards to applicant's argument that "Ericson does not teach two printers: one printer having a higher resolution than the other printer," the examiner respectfully disagrees.

The examiner points out that Rignell teaches using the two printers, where one printer is used for printing the position coding pattern and another printer to print the content. This is shown Page 2, paragraph 22 and Figure 3, element 301. Rignell describes that in paragraph 22 that the sheets are preprinted with the digital pattern. This is implied that they are not printed with the same printer, but with a different printer. This is further clarified though element 301 and in paragraph 52, where Rignell describes the step of buying the preprinted sheets. By buying the preprinted sheets, then they are printed by a printer that is different from the user's printer. The user's printer is used to print the content. Therefore, there are clearly two printers being used to print the digital pattern and the content.

Ericson is used to show that it is necessary to have a high resolution when printing the digital pattern. This is described in paragraph 37. Ericson states that the digital pattern should be printed on a printer that has a "sufficiently high printing resolution." By applying this principle to the teaching of two printers by Rignell, then the printer that prints the digital pattern would have a sufficiently high printing resolution.

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When you have two printers, the two different printers, the two different printers are not going to have the same printing resolution. One printer is going to have a higher printing resolution than the other. Based on Ericson's teachings, the printer that has the high resolution should be used to print the digital pattern. This will allow for the digital pattern to be printed on the printer that has a sufficiently high printing resolution. This means that the printer that prints the digital pattern will have a high printing resolution than the printer printing the content. By applying this to the two printers of Rignell, the printer that prints the digital pattern will have a higher printing resolution than the printer that prints the content. Therefore, Rignell in view of Ericson does teach "two printers: one printer having a higher resolution than the other printer."

3. In regards to applicant's argument that Rignell does not teach a "machine-readable identity code," the examiner respectfully disagrees.

Rignell teaches in paragraph 50 that the digital pen will read from the paper data such as the ID of the product. The applicant states that Rignell is not specific as to what the ID of the product is and therefore does not correspond to the machine-readable identity code. The examiner points out that in paragraph 69, the ID of the product "identifies the logical page on the imaginary surface that corresponds to the substrate." In other words, this is an ID that is read by the pen that identifies the paper. A machine-readable identity code needs to be read by some type of machine to identify the paper. The pen is a machine which reads the identity code which corresponds to the paper. Therefore, Rignell does teach "a machine-readable identity code."

4. In regards to applicant's argument that Kardach does not teach the "machine-readable identity code," the examiner notes that this is moot because Rignell is proven to have taught this point.

However, Kardach is used to teach a machine-readable identity code in regards to teaching the limitation of transferring the machine-readable code to the paper. In paragraph 20, Kardach describes identification information being printed on the paper. The identification information is described as an ID to identify the paper. In paragraph 21, the identification is described as being read by the pen to identify the paper. Since the pen is a machine and identification information is clearly an identity code of the paper, then Kardach does teach a "machine-readable identity code."

5. In regards to applicant's argument that Kardach fails to teach "transferring a machine-readable identity code between said second printer and said sheet," the examiner respectfully disagrees.

As described above, the machine-readable identity code is clearly described in paragraphs 20 and 21 of Kardach, where Kardach discuss how the identification information relates to the page. The identification information is clearly described as being printed onto the page in paragraph 21. Since the pattern is preprinted, as described in paragraph 19, this means that the pattern was printed by a first printer and a second printer is used to print the content, which includes the identification information. The identification information is used to associate the paper with the

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application. The Kardach application is described as taking an application and printing it onto a piece of paper. This content printed on the page is shown in figures 2-4. It is clear though these figures that the application means the document that is used in association with a specific application, not solely the application itself. In paragraph 34, Kardach proceeds to describe the different edits that are made to the paper in association with document. The edits are then associated with the application when printed, a digital representation of what is on the paper. One knows that you can not print a specific application because an application is merely a set of computer programs that are executed by a computer. Karadach clearly shows that the printed document relates to a visual representation of what is displayed on the application in association with a specific document, i.e. a calendar or a map as shown in Figures 3 and 4. The application itself would not correspond specifically to a calendar or a map unless a document was loaded in respect to the application. Therefore, the term of printed application in Kardach does in fact relate to a digital document. Therefore, Kardach does teach "transferring a machine-readable identity code between said second printer and said sheet."

6. In regards to applicant's argument that Euchner does not teach "in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific content along with said human discernible content onto said pre-printed digital paper," the examiner respectfully disagrees.

The identity code taught by Euchner is shown in Column 5, lines 41-55. Euchner teaches that each user will have their own printout of the hardcopy. The printout will have a uniquely identifiable copy. By having a uniquely identifiable copy, this would be a copy that is only associated with one user. By associating the copy to the one user, this would mean that it is user specific content. Since each printout is printed locally, then all the printouts are printed by each individual user, with each user's own printer. This relates to user-specific content. User-specific content is just content that is printed that is relates or is associated with a particular user. Euchner's teachings clearly show that this is user-specific content. There is no mention in the claims that this is information about the user, only that the content relates to the user. Therefore, Euchner does teach "in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific content along with said human discernible content onto said pre-printed digital paper."

7. Applicant's arguments, see pages 2-16, filed 07/19/10, with respect to claims 2 and 6-9 have been fully considered and are persuasive. The 103(a) of 03/22/10 has been withdrawn.

Allowable Subject Matter

8. Claims 2 and 6-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Objections

9. Claim 1 objected to because of the following informalities: Claim 1 claims "... (ii) the identity of a sheet..." The claim should read (ii) the identity of said sheet ...
Appropriate correction is required.

10. Claim 12 is objected to because of the following informalities: Claim 12 claims "... using said second printer to convey an identity code to or from the paper ..." The claims should read using said second printer to convey and identity code to or from said digital paper.... Appropriate correction is required.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1, 12, and 52 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to

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which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 claims that the machine-readable identity code is transferred between the second printer and the sheet. The code appears to be data and therefore data cannot be transferred between an electronic machine and a piece of paper. Claim 12 claims that the identity code is conveyed between the second printer and the sheet. Again, the code cannot be conveyed between an electronic machine and a piece of paper. Claim 52 also claims that the identity code is transferred between the second printer and the sheet. Again, the code cannot be transferred between an electronic machine and a piece of paper.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1, 3-5, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rignell (US 2003/0122746) in view of Kardach (US 2003/0001020) further in view of Ericson (US 2002/0050982).

Regarding Claim 1, Rignell teaches a method of associating in computer memory
(Page 2, paragraph 16)

(i) a digital electronic version of printed human-discernible content of a printed document comprising a sheet having a machine-readable pattern adapted to enable the position of a digital pattern reading device to be determined (Page 3, paragraph 48) and said human-discernible content with

(ii) the identity of a sheet upon which the content is printed (Page 3, paragraph 50), the method comprising:

printing the content onto a sheet using a second printer, said sheet comprising a pre-patterned sheet that has been pre-printed by a first printer with said pattern (Page 2, paragraph 22 and Figure 3, element 301, wherein it is shown that the preprinted sheets are bought, therefore not printed on the same printer); and

storing a correlation between said identity code and said digital electronic version in computer memory (Page 5, paragraph 69).

Rignell does not teach in which said first print has a higher print resolution than the second printer; and

transferring a machine-readable identity code between said second printer and said sheet at around the time of printing said content.

Ericson does teach in which said first print has a higher print resolution than the second printer (Page 3, paragraph 37, wherein Ericson shows that it is necessary to have a high resolution when printing the digital pattern. When you have two printers, as taught in Rignell, the two different printers, the two different printers are not going to have the same printing resolution. One printer is going to have a higher printing resolution than the other. Based on Ericson's teachings, the printer that has the high

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resolution should be used to print the digital pattern. This will allow for the digital pattern to be printed on the printer that has a sufficiently high printing resolution. This means that the printer that prints the digital pattern will have a high printing resolution then the printer printing the content. By applying this to the two printers of Rignell, the printer that prints the digital pattern will have a higher printing resolution then the printer that prints the content.).

Rignell and Ericson are combinable because they both teach making using digital paper for printing.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Ericson for the purpose of allowing the user to successfully print the position-coding pattern themselves using the proper type of printer (Ericson: Page 3, paragraph 37).

Kardach teaches teach transferring a machine-readable identity code between said second printer and said sheet at around the time of printing said content (Page 2, paragraph 21).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 3, Rignell does not teach wherein said identity code is printed on said sheet by said second printer.

Kardach does teach wherein said identity code is printed on said sheet by said second printer (Page 1, paragraph 11).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 4, Rignell does not teach wherein a plurality of sheets have the same pre-printed pattern as provided by the first printer and are given individual identities by using said second printer to apply different machine-readable identity codes to each of them at around the time of printing each sheet.

Kardach does teach wherein a plurality of sheets have the same pre-printed pattern as provided by the first printer and are given individual identities by using said second printer to apply different machine-readable identity codes to each of them at around the time of printing each sheet (Page 3, paragraph 27).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 5, Rignell does not teach wherein said machine-readable identity code comprises at least one code from the group:

- (i) a pattern of dots;
- (ii) a pattern of lines;
- (iii) a pattern of printed objects whose positions and/or shapes code for an identity;
- (iv) a position determining pattern;
- (v) a bar code.

Kardach does teach wherein said machine-readable identity code comprises at least one code from the group:

- (i) a pattern of dots;
- (ii) a pattern of lines;
- (iii) a pattern of printed objects whose positions and/or shapes code for an identity;
- (iv) a position determining pattern;
- (v) a bar code (Page 3, paragraph 34).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 24, Rignell further teaches wherein pre-printed digital paper is taken from said first printer and put into a plurality of second printers (Page 2, paragraph 22 Page 4, paragraph 52).

15. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rignell (US 2003/0122746) in view of Kardach (US 2003/0001020) further in view of Ericson (US 2002/0050982) further in view of Euchner (US 7,111,230).

Regarding Claim 6, Rignell further teaches said second printer uses data from a digital electronic version of content to print said content onto said pre-patterned sheet (Page 2, paragraph 22); and

wherein said association is made in computer memory between said digital electronic version of said content and said identity of pattern (Page 3, paragraph 48).

Rignell in view of Kardach further in view of Ericson does not teach wherein the second printer which prints said content onto said pre-patterned sheet has a pattern

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reading device, and wherein said second printer acquires data from said pre-printed pattern on the said sheet that is to be printed with content, in order to enable the identity of pattern on said sheet to be established, thereby enabling said association to be made in computer memory.

Euchner does teach wherein the second printer which prints said content onto said pre-patterned sheet has a pattern reading device, and wherein said second printer acquires data from said pre-printed pattern on the said sheet that is to be printed with content, in order to enable the identity of pattern on said sheet to be established, thereby enabling said association to be made in computer memory (Column 9, lines 19-38, wherein Rignell shows that the pattern is printed on a separate printer beforehand).

Rignell and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach further in view of Ericson with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 7, Rignell in view of Kardach further in view of Ericson does not teach wherein said pre-printed pattern is associated in computer memory with specific digital electronic content and wherein upon recognition of said pattern using data acquired by said pattern reading device of said second printer, said specific digital

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electronic content is caused to be printed onto said pre-patterned sheet as human-discernible content.

Euchner teaches wherein said pre-printed pattern is associated in computer memory with specific digital electronic content and wherein upon recognition of said pattern using data acquired by said pattern reading device of said second printer (Column 9, lines 19-38, wherein Rignell shows that the pattern is printed on a separate printer beforehand), said specific digital electronic content is caused to be printed onto said pre-patterned sheet as human-discernible content (Column 9, lines 19-38, wherein Rignell shows that the pattern is printed on a separate printer beforehand).

Rignell and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach further in view of Ericson with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 8, Rignell in view of Kardach further in view of Ericson does not teach wherein different users have different pattern associated with them and wherein upon recognition of their pattern from data from said second printer's pattern reading device said content printer is caused to print user-specific content onto said sheet.

Euchner does teach wherein different users have different pattern associated with them and wherein upon recognition of their pattern from data from said second

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printer's pattern reading device said content printer is caused to print user-specific content onto said sheet (Column 5, lines 47-55).

Rignell and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach further in view of Ericson with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 9, Rignell further teaches wherein said human-discernible content comprises document-type content and user-specific content, wherein one from the group:

(i) document-specific content; and

(ii) user-specific content is selected by a user, and the other from said group is obtained from a predetermined correlation between said identity code that has been read by said printer and a digital electronic version said content (Page 3, paragraph 48).

16. Claims 12, 13, 14-16, 18, 19, 21, 52, 75 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over obviousness by Rignell (US 2003/0122746) in view of Kardach (US 2003/0001020) further in view of Euchner (US 7,111,230).

Regarding Claim 12, Rignell teaches a method of associating in computer memory a digital electronic version of printed human discernible content of a printed document with an identity code adapted to identify said document (Page 3, paragraph 48), the method comprising:

using a plurality of pages of pre-patterned digital paper that have been pre-printed by a first printer with a position-determining pattern, said pattern being adapted to enable a digital pen to acquire information from said pattern to enable the position of said pen on said pattern to be determined (Figure 3, element 301 Page 3, paragraph 37, and Page 4, paragraph 51, wherein it is shown that the preprinted sheets are bought, therefore not printed on the same printer);

printing said content on said digital paper using a second printer (Page 2, paragraph 22); and

and associating in computer memory, using said code transferred, at the time of printing said content onto said pre-patterned paper, a digital electronic version of said content with the identity code for the particular sheet of digital paper upon which said content is printed (Page 5, paragraph 69).

Rignell does not teach using said content printer to convey an identity code to or from the paper; and

in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific content along with said human discernible content onto said pre-printed digital paper.

Kardach does teach using said content printer to convey an identity code to or from the paper (Page 2, paragraph 21).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Euchner does teach in which said identity code is a user-specific identity code and in which, upon recognition of said user-specific identity code, said second printer is caused to print user-specific content along with said human discernible content onto said pre-printed digital paper (Column 5, lines 46-55, wherein by having the pattern be established has specific to a user, the pattern is then an identity code of a user. This way all the edits are associated with each user based on the pattern. There is no limitation in the claim that states that information about the user is printed with the content of the page, only that the identity code which identifies the user is printed with the content.).

Rignell in view of Kardach and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with the

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teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 13, Rignell does not teach wherein an identity code adapted to distinguish a specific sheet of pre-pattern digital paper is printed onto said specific sheet as part of an operation of printing said content onto said specific sheet, said identity code being readable by a digital pen and being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre- patterned paper having the same position-determining pattern on them as does said specific sheet

Kardach teaches wherein an identity code adapted to distinguish a specific sheet of pre-pattern digital paper is printed onto said specific sheet as part of an operation of printing said content onto said specific sheet, said identity code being readable by a digital pen and being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet (Page 3, paragraph 27).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of

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Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 14, Rignell in view of Kardach does not teach wherein an identity code adapted to distinguish a specific sheet of pre-patterned digital pattern is printed on said specific sheet in an operation prior to printing said content onto said specific sheet, and wherein a second printer which prints said content onto said pre-patterned paper has an identity code reading device, said second printer being capable of acquiring data from said identity code, said identity code being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet, to enable said association to be made between said digital electronic version of said content and said identity code

Euchner teaches wherein an identity code adapted to distinguish a specific sheet of pre-patterned digital pattern is printed on said specific sheet in an operation prior to printing said content onto said specific sheet, and wherein a second printer which prints said content onto said pre-patterned paper has an identity code reading device, said second printer being capable of acquiring data from said identity code, said identity code being capable of being used to distinguish data acquired by a digital pen from said specific sheet from data acquired by said pen from other sheets of pre-patterned paper having the same position-determining pattern on them as does said specific sheet, to

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enable said association to be made between said digital electronic version of said content and said identity code (Column 8, lines 4-10 and Column 9, line 19-25).

Rignell in view of Kardach and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 15, Rignell does not teach wherein a plurality of different identity codes are printed on a respective plurality of pre-patterned sheets each having the same pre-printed position-determining pattern, said identity codes enabling a digital pen to acquire sheet identity data to enable data acquired from each sheet to be distinguished from data acquired from other sheets

Kardach teaches wherein a plurality of different identity codes are printed on a respective plurality of pre-patterned sheets each having the same pre-printed position-determining pattern, said identity codes enabling a digital pen to acquire sheet identity data to enable data acquired from each sheet to be distinguished from data acquired from other sheets (Page 3, paragraph 27).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 16, Rignell in view of Kardach does not teach wherein said identity code is associated in computer memory with specific digital electronic content and wherein upon recognition of said identity code using data acquired by said identity code reading device of said second printer, said specific digital electronic content is caused to be printed onto said pre-patterned sheet as human discernible content.

Euchner further teaches wherein said identity code is associated in computer memory with specific digital electronic content and wherein upon recognition of said identity code using data acquired by said identity code reading device of said second printer (Column 9, lines 19-25), said specific digital electronic content is caused to be printed onto said pre-patterned sheet as human discernible content (Column 9, line 19-25).

Rignell in view of Kardach and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 18, Rignell does not teach wherein said identity code is printed in an area of said pre-patterned paper which is from the group:

- (i) free of pattern;
- (ii) substantially free of pattern (Page 3, paragraph 30).

Kardach teaches wherein said identity code is printed in an area of said pre-patterned paper which is from the group:

- (i) free of pattern;
- (ii) substantially free of pattern (Page 3, paragraph 30).

Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

Regarding Claim 19, Rignell further teaches wherein an area of said sheets from the group:

- (i) all of a surface of each of the sheets;
- (ii) substantially all of a surface of each of the sheets;
- (iii) at least half of the surface area of each of the sheets;
- (iv) at least a tenth of the surface area of each of the sheets;

are pre-printed with pattern (Page 3, paragraph 38).

Regarding Claim 21, Rignell further teaches wherein said second printer is

(i) not capable of printing said pattern satisfactorily; or

(ii) configured not to be capable of printing said pattern satisfactorily (Page 2, paragraph 22).

Regarding Claim 52, Rignell teaches a method of combining pen strokes made with a digital pen upon a digital sheet having pen position-determining pattern printed upon it and human-discernible content printed upon it (Page 3, paragraphs 31 and 33) comprising:

printing said sheet with said pattern in a pre-patterning operation with a first printer to create a pre-patterned sheet (Figure 3, element 301 Page 3, paragraph 37, and Page 4, paragraph 51, wherein it is shown that the preprinted sheets are bought, therefore not printed on the same printer);

subsequently printing said content onto said pre-patterned sheet using a second printer to create a content-printed digital sheet (Page 2, paragraph 22);

associating in computer memory a link between said identity code and an electronic version of said content that was printed on said sheet (Page 5, paragraph 69);

using a digital pen to make pen strokes on said content-printed sheet (Page 3, paragraph 39);

conveying pen-acquired pen-position data, relating to the position of said pen in said pattern to a processor (Page 3, paragraph 39);

the processor using the pen-acquired identity code, the pen acquired pen-position data, and the link between said identity code and said electronic version of said content to combine said pen strokes with said content (Page 3, paragraphs 39 and 49, wherein the identify code is acquired from Kardach).

Rignell does not teach transferring an identity code between said second printer and said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet writing operation, the transfer of said identity code occurring in the same time frame as printing said content onto said sheet;

in which said identity code corresponds to a predetermined set of human-discernible content and in which, upon recognition of said identity code, said second printer is caused to print user-specific content along with said predetermined set of human-discernible content onto said pre-printed digital paper;

using the digital pen to acquire said identity code from said content- printed sheet.

Kardach does teach transferring an identity code between said second printer and said sheet to enable the identity of said sheet to be established in a subsequent pen-on-sheet writing operation, the transfer of said identity code occurring in the same time frame as printing said content onto said sheet (Page 2, paragraph 21);

using the digital pen to acquire said identity code from said content- printed sheet (Page 2, paragraph 26).

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Rignell and Kardach are combinable because they both teach making edits with digital paper.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell with the teachings of Kardach for the purpose of allowing the document to be distinguished between other document though the use of an identifier (Kardach: page 1, paragraph 11).

in which said identity code corresponds to a predetermined set of human-discernible content and in which, upon recognition of said identity code, said second printer is caused to print user-specific content along with said predetermined set of human-discernible content onto said pre-printed digital paper (Column 5, lines 46-55, wherein by having the pattern be established has specific to a user, the pattern is then an identity code of a user. This way all the edits are associated with each user based on the pattern. There is no limitation in the claim that states that information about the user is printed with the content of the page, only that the identity code which identifies the user is printed with the content.).

Rignell in view of Kardach and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

Regarding Claim 75, Rignell does not teach said user-specific content is accessed by said second printer from a memory within said second printer.

Euchner does teach said user-specific content is accessed by said second printer from a memory within said second printer (Column 5, lines 46-55, wherein by having the pattern be established has specific to a user, the pattern is then an identity code of a user. This way all the edits are associated with each user based on the pattern. The user specific pattern must be stored in memory before it can be printed. When a document is to be printed it stores the print data in a printer memory before printing the data. This allows for access to the print data. Therefore, when a command to print the user specific code is sent then the user specific code is retrieved from the printer memory in order to print the user specific code on the sheet).

Rignell in view of Kardach and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55)

Regarding Claim 76, Rignell does not teach said user-specific content is accessed by said second printer from a print command sent to said second printer.

Euchner does teach said user-specific content is accessed by said second printer from a print command sent to said second printer (Column 5, lines 46-55,

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wherein by having the pattern be established has specific to a user, the pattern is then an identity code of a user. This way all the edits are associated with each user based on the pattern. When a command to print the document with the user specific pattern is sent to the printer, the user specific pattern must be printed).

Rignell in view of Kardach and Euchner are combinable because they all deal with editing digital documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach with the teachings of Euchner for the purpose of identifying the user who made the edits (Euchner: Column 5, lines 41-55).

17. Claim 72 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rignell (US 2003/0122746) in view of Kardach (US 2003/0001020) further in view of Ericson (US 2002/0050982) further in view of Korst (US 7,050,181).

Regarding Claim 72, Rignell in view of Kardach further in view of Ericson does not teach wherein the second printer is an existing legacy printer.

Korst does teach wherein the second printer is an existing legacy printer (Column 2, lines 11-33, wherein Korst states to modify an existing legacy printer to accept commands as if it was a regular printer. Therefore since Korst states that a legacy printer can function as a regular printer, Rignell's printer can be modified to be a legacy printer.).

Rignell in view of Kardach and Korst are combinable because they both teaching printing documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach further in view of Ericson with Korst for the purpose of having a legacy printer function as a current printer (Column 2, lines 11-15).

18. Claims 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rignell (US 2003/0122746) in view of Kardach (US 2003/0001020) further in view of Euchner (US 7,111,230) further in view of Korst (US 7,050,181).

Regarding Claim 73, Rignell in view of Kardach further in view of Euchner does not teach wherein the second printer is an existing legacy printer.

Korst does teach wherein the second printer is an existing legacy printer (Column 2, lines 11-33, wherein Korst states to modify an existing legacy printer to accept commands as if it was a regular printer. Therefore since Korst states that a legacy printer can function as a regular printer, Rignell's printer can be modified to be a legacy printer.).

Rignell in view of Kardach and Korst are combinable because they both teaching printing documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach further

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in view of Euchner with Korst for the purpose of having a legacy printer function as a current printer (Column 2, lines 11-15).

Regarding Claim 74, Rignell in view of Kardach further in view of Euchner does not teach wherein the second printer is an existing legacy printer.

Korst does teach wherein the second printer is an existing legacy printer (Column 2, lines 11-33, wherein Korst states to modify an existing legacy printer to accept commands as if it was a regular printer. Therefore since Korst states that a legacy printer can function as a regular printer, Rignell's printer can be modified to be a legacy printer.).

Rignell in view of Kardach and Korst are combinable because they both teaching printing documents.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Rignell in view of Kardach further in view of Euchner with Korst for the purpose of having a legacy printer function as a current printer (Column 2, lines 11-15).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas C. Pachol whose telephone number is 571-270-3433. The examiner can normally be reached on M-Thr, 8:00 a.m.- 4:00 p.m. (EST), Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on 571-272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. C. P./
Examiner, Art Unit 2625

10/09/10

/Twyler L. Haskins/
Supervisory Patent Examiner, Art Unit 2625